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OFFICE OF PETITIONS

In re Application of :
Frank et al. : DECISION ON APPLICATION
Application No. 10/658,578 : FOR PATENT TERM ADJUSTMENT
Filed: September 9, 2003 :
Attorney Docket No. 14181US02 :

This is in response to the paper filed August 23, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(b) requesting the initial determination of patent term adjustment be corrected from eight hundred ninety (890) days to two thousand two hundred sixty-one (2,261) days.

The application for patent term adjustment is **dismissed**.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) on July 9, 2010, advising Applicants of a patent term adjustment to date of 890 days. In response, Applicants timely filed this application for patent term adjustment on August 23, 2010, prior to the submission of the issue fee on September 30, 2010.

The patent term adjustment determination of 890 days mailed with the Notice of Allowance consists of 892 days of delay under 37 C.F.R. § 1.703(a)(1) reduced by 2 days of delay under 37 C.F.R. § 1.704(b).

Applicants assert the correct patent term adjustment is 2,261 days, which is the sum of 892 days of delay under 37 C.F.R. § 1.703(a)(1) and 1,592 days of delay under 37 C.F.R. § 1.703(b) reduced by 223 days of overlap between the two periods of Office delay.

Delay Under 37 C.F.R. § 1.703(b)

To the extent applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination (RCE)

was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

Delay Under 37 C.F.R. § 1.704(b)

Applicants assert the Office's entry of a 2-day reduction for delay under 37 C.F.R. § 1.704(b) was improper.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 C.F.R. § 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 C.F.R. § 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 C.F.R. § 1.705(b) and 35 U.S.C. § 154(b)(3)(B). A dispute as to the calculation of the 37 C.F.R. § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) will be dismissed as untimely filed.

time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

The Office mailed a non-final Office action on October 5, 2007, which set a shortened statutory period for reply of three (3) months. Applicants filed a reply on Monday, January 7, 2007. Applicants argue a reduction in patent term adjustment is not warranted for delay in filing the reply because the due date to file a reply fell on a Saturday and January 7, 2007, was the first succeeding day that was not a Saturday, Sunday, or a Federal holiday.

37 C.F.R. § 1.7(a) states,

When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding business day which is not a Saturday, Sunday, or a Federal holiday.

The Office recognizes, pursuant to 37 C.F.R. § 1.7(a), the due date for a reply to the October 5, 2007 Office action was shifted to Monday, January 7, 2007, absent payment for an extension of time. However, the due date for a reply to a notice or Office action is irrelevant when applying the provisions of 37 C.F.R. § 1.704(b). Specifically, 37 C.F.R. § 1.704(b) states, “The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.”

Pursuant to 37 C.F.R. § 1.7(a), the January 7, 2007 reply was a timely response to the prior Office action. However, the fact a reply is timely does not preclude a reduction under 37 C.F.R. § 1.704(b). For example, if an Office action sets forth a shortened statutory period for reply of 3 months, and a reply is filed 3 months and 75 days later with payment for a with payment for a three-month extension of time, a 75-day reduction will be warranted under 37 C.F.R. § 1.704(b) even though the reply is timely.

In view of the prior discussion, the Office’s entry of a 2-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) was proper.

Conclusion

The initial patent term adjustment remains 890 days, which is 892 days of delay under 37 C.F.R. § 1.703(a)(1) reduced by 2 days of delay under 37 C.F.R. § 1.704(b).

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

Applicants are reminded any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



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